

GNF Docket No.: P0026US20  
 Confirmation No.: 4754

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PTO/SB/97 (08-03)

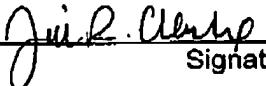
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I hereby certify that this correspondence for U.S. Patent Application No. 10/054,498 filed January 22, 2002 in re John B. Welsh, et al. is being facsimile transmitted to the United States Patent and Trademark Office at facsimile number (703) 872-9306 on December 6, 2004.

Date



Signature

Jill R. Clarke

Typed or printed name of person signing Certificate

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 Genomics Institute of the Novartis Research Foundation  
 Telephone: 858-812-1855  
 Fax: 858-812-1981

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

#### Attachments:

1. Form PTO/SB/21 Transmittal Form (1 pg.);
2. Form PTO/SB/17 Fee Transmittal with authorization to charge Deposit Account No. 50-1885 in the amount of \$110 for one month extension of time (1 pg. + 1 pg. copy);
3. Response to Restriction Requirement mailed October 5, 2004 (6 pgs.); and
4. Fax Cover Sheet with Certificate of Transmission under 37 CFR 1.8 (1 pg.).

#### Total pages (including this paper): 10

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEE TRANSMITTAL  
for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 110)

Complete If Known	
Application Number	10/054,498
Filing Date	01/22/2002
First Named Inventor	John B. Welch
Examiner Name	UNGAR, SUSAN NMN
Art Unit	1642
Attorney Docket No.	P0026US20

## METHOD OF PAYMENT (check all that apply)

 Check    Credit card    Money    Other    None  
 Deposit Account

Deposit Account Number 50-1885

Deposit Account Name Genentech Institute of the Novartis Research Foundation

The Director is authorized to: (check all that apply)

 Charge fee(s) indicated below    Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee			
1002 350	2002 175	Design filing fee			
1003 550	2003 275	Plant filing fee			
1004 790	2004 395	Reissue filing fee			
1005 160	2005 80	Provisional filing fee			

SUBTOTAL (1)

(\$ 0)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	-20 **	=	Extra Claims	Fee from below	=	Fee Paid
Independent Claims	-3 **	=	0	X	=	0
Multiple Dependent		X			=	0
Large Entity	Small Entity					
Fee Code (\$)	Fee Code (\$)					
1202 18	2202 9					
1201 88	2201 44					
1203 300	2203 150					
1204 88	2204 44					
1205 18	2205 9					

SUBTOTAL (2)

(\$ 0)

\*\*or number previously paid, if greater. For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath			
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet			
1053 130	1053 130	Non-English specification			
1812 2,520	1812 2,520	For filing a request for ex parte reexamination			
1804 920*	1804 820*	Requesting publication of SIR prior to Examiner action			
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action			
1251 110	2251 55	Extension for reply within first month			110
1252 430	2252 215	Extension for reply within second month			
1253 980	2253 480	Extension for reply within third month			
1254 1,530	2254 785	Extension for reply within fourth month			
1255 2,080	2255 1,040	Extension for reply within fifth month			
1401 340	2401 170	Notice of Appeal			
1402 240	2402 170	Filing a brief in support of an appeal			
1403 300	2403 150	Request for oral hearing			
1451 1,510	1451 1,510	Petition to institute a public use proceeding			
1452 110	2452 55	Petition to revive - unavoidable			
1453 1,370	2453 685	Petition to revive - unintentional			
1601 1,370	2501 685	Utility issue fee (or reissue)			
1502 490	2502 245	Design issue fee			
1503 660	2503 330	Plant issue fee			
1450 130	1480 130	Petitions to the Commissioner			
1807 50	1807 50	Processing fee under 37 CFR 1.17 (q)			
1806 180	1808 180	Submission of Information Disclosure Stmt			
8021 40	8021 40	Recording each patent assignment per property (times number of properties)			
1809 790	2809 396	Filing a submission after final rejection (37 CFR § 1.129(a))			
1810 790	2810 395	For each additional invention to be examined (37 CFR § 1.129(b))			
1801 760	2801 395	Request for Continued Examination (RCE)			
1802 900	1802 900	Request for expedited examination of a design application			

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 110)

Complete (if applicable)

Name (Print/Type)	Hugh Wang	Registration No. (Attorney/Agent)	47,163	Telephone	858-612-1539
Signature				Date	December 6, 2004

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# FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 110)

Complete if Known

Application Number	10/054,498
Filing Date	01/22/2002
First Named Inventor	John B. [REDACTED]
Examiner Name	UNGA [REDACTED] NM
Art Unit	1842
Attorney Docket No.	P0026US20

**COPY**

## METHOD OF PAYMENT (check all that apply)

 Check  Credit card  Money  Other  None  
 Order
 Deposit Account:

Deposit Account Number

56-1885

Deposit Account Name

Genomics Institute of the Novartis Research Foundation

The Director is authorized to: (check all that apply)

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 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1006	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$ 0)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	-20-	Extra Claims	Fee from below	Fee Paid
Independent Claims	-3-	= 0	X = 0	= 0
Multiple Dependent		X = 0		= 0

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	-- Reissue independent claims over original patent
1205	18	2205	9	-- Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0)

\*or number previously paid, if greater. For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051	130	2051	66	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	56	Extension for reply within first month	110
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	480	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,270	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	480	2502	245	Design issue fee	
1503	680	2503	930	Plant issue fee	
1480	130	1460	130	Petitions to the Commissioner	
1607	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1808	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	800	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 110)

## SUBMITTED BY

Name (Print/Type)	Hugh Wong	Registration No. (Attorney/Agent)	47,163	Telephone	858-612-1539
Signature				Date	December 6, 2004

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PTO/SB/21 (09-04)  
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FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	10	Attorney Docket Number	P0026US20
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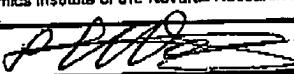
**ENCLOSURES (check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (Please Identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Form PTO/SB/17 Fee Transmittal with authorization to charge Deposit Account No. 50-1885 in the amount of \$110 for one month extension of time (1 pg. + 1 pg. copy); Response to Restriction Requirement mailed October 6, 2004 (6 pgs.); Certificate of Facsimile Transmittal (1 pg.)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks The Director is authorized to charge any additional fees to Deposit Account No. 50-1885.

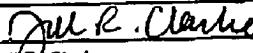
A one-month extension of time to reply to the Restriction Requirement mailed on October 6, 2004 is respectfully requested.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm	Genomics Institute of the Novartis Research Foundation		
Signature			
Printed Name	Hugh Wang		
Date	December 6, 2004	Reg. No.	47,163

**CERTIFICATE OF TRANSMISSION**

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Signature		Date	December 6, 2004
Typed or printed name	Jill R. Clarke		

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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2004

By: Jill R. Clarke  
Jill R. Clarke

DEC 06 2004 PATENT  
Attorney Docket No.: P0026US20

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John B. WELSH *et al.*

Application No.: 10/054,498

Filed: January 22, 2002

For: GENES OVEREXPRESSED IN  
PROSTATE DISORDERS AS  
DIAGNOSTIC AND  
THERAPEUTIC TARGETS

Examiner: Susan Ungar, Ph.D.

Art Unit: 1642

Response to Restriction Requirement

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450

This is submitted in response to the Restriction Requirement mailed October 5, 2004 in the above-captioned patent application. A one-month extension of time is requested with this reply. Applicants request reconsideration of the Requirement for Restriction.

The Restriction Requirement restricted the pending claims into 10 separate groups. In addition, it alleged that there are  $4.5 \times 10^{105}$  different inventions in each group. It required Applicants to elect one of the groups and also one invention from the alleged  $4.5 \times 10^{105}$  different inventions. The basis for the restriction was that "Tables 2, 3 and 4 consist of 73